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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/298,505

Applicant(s)

HOLM-BLAGG ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25,30-57 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25,30-34,36-41,45,46,48-53,55,56 and 59-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 35,42-44,47,54,57, and 62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection (Paper No. 11). Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office Action on the merits (Paper No. 11) has been withdrawn pursuant to 37 C.F.R. §114.

Acknowledgements

2. In accordance with the RCE noted above, Applicants' amendment filed April 23, 2002 (Paper No. 13) has been entered. Accordingly, claims 25, 30-57, and 59-62 remain pending.
3. However in light of Applicants' responses noted below, an examination on the merits of claims 25, 30-34, 36-41, 45, 46, 48-53, 55, 56, and 59-61 is set forth in this Office Action.
4. Applicants' correction of Inventorship (Paper No. 23) is also acknowledged.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Restriction

6. Applicants' election with traverse of Group I in Paper No. 19 is acknowledged. The traversal is on the ground(s) that "no claims are generic."¹ This is not found persuasive because Applicants' own response filed January 9, 2004 (Paper No. 22) contradicts this statement. If *all*

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pending claims were generic, Applicants' would have indicated that *all pending claims* read on the elected invention. After review of Page 1 in Paper No. 22, it clearly evident that this is not the case. The requirement is still deemed proper and is therefore made FINAL.

7. Claims 58 and 62 are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected invention, there being no allowable linking claim. Applicants timely traversed the restriction requirement in Paper Nos. 19 and 22.

Election of Species

8. Applicants' election with traverse of Species A3 in Paper No. 19 is also acknowledged. The traversal is on the ground(s) that "no claims are generic."² This is not found persuasive because again, Applicants' latest response filed January 9, 2004 (Paper No. 22) contradicts this statement. Applicants' latest response (Paper No. 22) indicates that claims 25, 36-41, 45, 46, 48-53, 55, 56, and 58-62 are readable on the elected species. Because of this statement, it is impossible for all pending claims to be generic. The requirement is still deemed proper and is therefore made FINAL.

9. Claims 35, 42-44, 47, 54, 57 are also withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected species, there being no allowable generic claim. Applicants timely traversed the election of species requirement in Paper Nos. 19 and 22.

¹ Applicants' Response filed March 13, 2003, Paper No. 19, Page 1.

² *Id.*

Claim Objections

10. Claim 53 objected to under 37 C.F.R. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The purpose of a claim does not further limit that claim. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Claim Rejections - 35 USC §101

11. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 25, 30-34, 36-41, 45, 46, 48-53, 55, 56, and 59-61 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

13. For a claimed invention to be statutory, the claimed invention must be within the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280, 289-90 (C.C.P.A. 1970); and *In re Johnston*, 502 F.2d 765, 183 USPQ 172, 177 (C.C.P.A. 1974). Mere abstract ideas (*i.e.*, laws of nature, natural phenomena) that do not apply, involve, use, or advance the

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technological arts fail to promote the “progress of science and the useful arts”³ and are therefore non-statutory subject matter.⁴

14. For a process, the claimed process must somehow apply, involve, use, or advance the technological arts. Mere intended or nominal use of a component—albeit within the technological arts—does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In other words, if the invention in the body of the claim is not tied to a technological art, environment, or machine, the claim is non-statutory. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (B.P.A.I. 2001) (Unpublished). See also MPEP §2106 IV B. 2 (b) ii). Databases functions, record functions, and their controls may be performed by hand (*i.e.* with pencil and paper). The Examiner recommends (by way of example only) recitation of a computer within the body of the claim if the specification supports such an amendment.

Claim Rejections - 35 USC §112 2nd Paragraph

15. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 25, 30-34, 36-41, 45, 46, 48-53, 55, 56, and 59-61 are rejected under 35

U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly

³ It is the Examiner’s position that “technological arts” is synonymous with “useful arts” as stated in the U.S. Constitution, Art. I, §8. See *In re Waldbaum*, 457 F.2d 997, 173 USPQ 430, 434 (C.C.P.A. 1972).

⁴ *E.g.*, the physical sciences: statutory; *c.f.*, social sciences: non-statutory

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claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

Claim 25 recites the limitation "said first account" in line 6. There is insufficient antecedent basis for this limitation in the claim. The "first account financial record" is a record and not an account. The Examiner interprets "first account financial" as modifiers of record.

In claim 33, the phrase "a settlement rule specific to the first financial record" is indefinite. It is not known what is encompassed by "a settlement rule"

In claim 49, the phrase "a business rule" is indefinite.

In claim 51, the phrase "distinct from rules used to define a relationship between the third financial record and the second group master record."

Because 25, 30-34, 36-41, 45, 46, 48-53, 55, 56, and 59-61 are rejected under §101, the scope of the patentable subject matter can not be determined at this time. If Applicants overcome the §101 rejections, this particular §112, 2nd paragraph rejection will be withdrawn.

17. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

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Claim Rejections - 35 USC §102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. Claims 25, 30-34, 36-41, 45, 46, 48-50, 52, 53, 55, 56, and 59-61, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by the prior art as noted in Applicants' disclosure. Applicants' disclosure beginning with "an individual can share ownership of credit products carried by other member of their family."⁵ In particular, this scenario directly or inherently discloses:

identifying a first financial record (a record of a sale using a child's card) associated with a first product (the product being the child's credit card); individual processing of the first financial record (the record being one credit card sale) is at least partially controlled by a first processing control (the first processing control being a CPU executing instructions having terms and conditions such as only the named person (child's name on the credit card) can use the credit card (product), credit limit for the child, etc.);

identifying a second financial record (a record of a sale using 2nd child's card); individual processing of the second financial record (the record being one credit card sale) is at least

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partially controlled by a second processing control (the second processing control being a CPU executing instructions having terms and conditions such as only the named person (2nd child's name on the credit card) can use the credit card (product), credit limit for the child, etc.);

creating a group master record (parent(s)' record) wherein the group master record associates the first financial record and the second financial record (the parent(s)' master record (such as name and billing address) is directly linked to the children's records);

defining at least one group processing control (controlling which children's accounts are to be totaled with the parent(s), totaling parent and all child accounts so that the accounts do not exceed an overall master account limit);

the first financial record is processed independent of the second financial record (all records are at least in part processed independent of all other records, *e.g.*, a first transaction is processed independent of any subsequent transaction); and wherein group master record facilitates group level processing (preparing a statement) in accordance with group processing control (the billing address, credit rate, billing cycle days, etc.).

20. Claims 25, 30-34, 36-41, 45, 46, 48-50, 52, 53, 55, 56, and 59-61, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Piciallo (U.S. 6,044,360). Piciallo discloses as previously discussed.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

⁵ See Applicants' originally filed disclosure, Page 3, beginning with line 9.

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 25, 30-34, 36-41, 45, 46, 48-50, 52, 53, 55, 56, and 59-61 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art as noted in Applicants' disclosure.⁶ It is the Examiner's principle position that the claims are anticipated because of the inherencies noted above.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the admitted prior art to include the various claimed features. Such modification would have directly discloses that which is old and well known in the art.

Allowable Subject Matter

23. Claim 51 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §101 and 35 U.S.C. §112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Construction

24. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual

⁶ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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findings. First and as noted in the previous Office Action on the merits,⁷ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements.⁸ Third, after receiving express notice in the previous Office Action on the merits of the Examiner's position that lexicography is not invoked,⁹ Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants have not argued lexicography is invoked). Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation¹⁰ to be their own lexicographer.¹¹ Accordingly and for due process purposes, the Examiner gives

⁷ See the Examiner's previous Office Action on their merits mailed January 23, 2002, Paper No. 11, Paragraph No. 7.

⁸ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁹ See again the Examiner's previous Office Action, Paper No. 11, Paragraph No. 7.

¹⁰ *Id.*

¹¹ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed April 4, 2004).

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notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).¹² The Examiner now relies heavily and extensively on this interpretation.¹³ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

25. To the extent that the Examiner’s interpretations are in dispute with Applicants’ interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹⁴ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.¹⁵ Finally, the following list is not intended to be exhaustive in any way:

¹² See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

¹³ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

¹⁴ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

¹⁵ See e.g. *Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

Server: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹⁶ **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.* **Computer:** “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

Internet “The worldwide collection of networks and gateways that use the TCP/IP suite of protocols to communicate with one another. At the heart of the Internet is a backbone of high-speed data communication lines between major nodes or host computers, consisting of thousands of commercial, government, educational, and other computer systems, that route data and messages.” *Id.*

Network “A group of computers and associated network devices that are connected by communications facilities.” *Id.*

Record “A data structure that is a collection of fields (elements), each with its own name and type. Unlike an array, whose elements all represent the same type of information and are accessed using an index, the elements of a record represent different types of information and are

¹⁶ Based upon Applicants’ disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled ‘New Terminology.’

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accessed by name. A record can be accessed as a collective unit of elements, or the elements can be accessed individually.” *Id.*

For “1 a — used as a function word to indicate purpose <a grant ~ studying medicine >” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Associate: “1: closely connected with one another . . .” *Id.*

Information “ 2 a . . . (3): FACTS, DATA . . .” *Id.*

26. Functional recitation(s) using the word “for” or other functional terms (*e.g.* “for linking two or more distinct financial records to create a group that facilitates group level processing” as recited in claim 30) have been considered but given less patentable weight¹⁷ because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See again *Bristol-Myers Squibb Co.*, 246 F.3d at 1375-76, 58 USPQ2d at 1513 (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

27. It is the Examiner’s factual determination that all limitations in the examined claims have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features—like the directly disclosed features—are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO

¹⁷ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

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making rejections.” (citations and quotations omitted)). The discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

Response to Arguments

28. Applicants’ arguments filed February 9, 2004 (Paper No. 22) have been fully considered but they are not persuasive.

29. Applicants’ argue that Piciallo “does not disclose, teach or suggest linking two distinct financial records.”¹⁸ The Examiner respectfully disagrees. Clearly a financial record created by a single transaction is linked. In fact, this linking occurs in an ordinary credit card.

30. Applicants’ remaining arguments have been considered and are either moot or unpersuasive.

Conclusion

31. The following references are considered pertinent to Applicants’ disclosure: Pitroda (U.S. 5,590,038) and Wynn (U.S. 5,859,419).

32. The following two (2) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

33. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement

¹⁸ Applicants’ Remarks filed January 9, 2004, Paper No. 22, Page 14, ¶3.

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mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will still require further consideration and/or search and a patentability determination as noted above.

34. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference *How Computers Work* 4th Ed. by Ron White is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The reference is cited in its entirety. Moreover, because the reference is directed towards beginners, because of the reference’s basic content (which is self-evident upon review of the reference), and after further review of both the intrinsic evidence of record and the art of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the reference is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the reference.

35. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the

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Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their “Remarks” (Paper No. 22 beginning on page 12) traversing the Examiner’s positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁹ the Examiner respectfully reminds Applicants to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner’s positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Patent Examiner
Art Unit 3627

AJF
April 4, 2004

¹⁹ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.